

## REMARKS

Reconsideration of the present application is respectfully requested. Claims 5-8 and 12 are rejected as failing to comply with the enablement requirement of 35 U.S.C. §112, ¶ 1. Claims 1 and 3-12 are rejected as failing to comply with the written description requirement set forth in the paragraph 1 of section 112. Claims 1, 5, 8-9, and 11 are rejected under 35 U.S.C. §102(b) as anticipated by JP10-227184. Claims 3, 6-7 and 10 are rejected under 35 U.S.C. §103(a) as unpatentable over JP '184 in view of Hunter U.S. Patent No. 6,697,517.

Concerning the rejection of claims 5-8 and 12 as failing to comply with the enablement requirement of 35 U.S.C. §112, ¶ 1, the applicants strongly disagree with the examiner's conclusions regarding nonenablement, as the examiner has not applied the correct legal standard. As a result, the applicants find that they have been prejudiced, as the application is now under final rejection.

The applicants contended in their previously submitted response under 37 C.F.R. § 1.111 that the claimed invention complies with the enablement requirement of 35 U.S.C. § 112 ¶ 1. The response set forth the relevant standard under which the enablement determination is made, and the relevant factors to be considered in making the determination. The standard, and the factors, have been enumerated by the United States Courts of competent jurisdiction in case law dating back to 1916. For reasons that only the examiner can know, he has not applied that standard here, and has failed to take the factors enumerated by the Courts into consideration. The errors committed by this approach are substantial, and such errors are prejudicial to the applicants.

Again, enablement is determined by considering and answering this question: is the experimentation needed to practice the invention undue or unreasonable? *Mineral Separation v.*

*Hyde*, 242 U.S. 261, 270 (1916)<sup>1</sup>. In contrast, the examiner merely concludes that “the claim(s) contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains...to make and/or use the invention”. Office action, paragraph 4, page 4. This statement completely at odds with the 1916 Supreme Court standard still applied to day, as the examiner give no consideration to the fact that he must consider whether experimentation, if necessary, is undue.

Accordingly, because the examiner has substantially misapplied the law, no *prima facie* case of nonenablement has been set forth here. The examiner is asked to reconsider and reapply the correct law. It is submitted that if this is done, the nonenablement rejection will not be restated in subsequent Office papers.

In any event, the claim 1 limitation “---with first and second read optical conditions ---” of claim 1, the description itself is not used in the specification, as permissible under the law of enablement. . The description of “—by automatic read under a plurality of read optical conditions registered in advance” on page 5, line 27 – page 6, line 1 corresponds to “first read optical condition”, and means a lot of optical conditions registered in advance.

Furthermore, “second read optical condition” means an optical condition after the change, not an advanced registration condition. It is supported by the part of “--- searches for an optical condition under which an ID can be read while changing read optical condition” on page 8, lines 1-3. Thus, the claimed invention here is clearly enabled.

The applicants must point out that through no fault of their own, they have been prejudiced by the application of the incorrect legal standard. The present application is under final rejection, yet is also clear that the rejection on enablement has not been joined, as the

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<sup>1</sup> The standard under which nonenablement is determined, and the relevant factors concerning same, are set forth in the applicants’ response of November 22, 2006.

rejection has been based on an impermissible reading of the law. Thus, in the event that the examiner does not agree that the application is in condition of allowance, the applicants believe that an advisory action would be wholly inappropriate here. The applicants would be prejudiced, having to spend funds to further prosecution or to appeal when an issue was never given proper consideration in the first place. For this reason, the applicants believe that in the event of non-allowance, the correct action from the Patent Office should be the issuance of a non-final office action.

Claims 1 and 3-12 are rejected as failing to comply with the written description requirement set forth in the paragraph 1 of section 112. The same can be said about the examiner's rejection under 35 U.S.C. §112 ¶ 1 on written description grounds. We demonstrated in detail that the specification describes the structure needed to perform the task in question, namely "the highest score being adopted only if it is at least equal to a predetermined minimum score."

As the applicants demonstrated on page 9 of their November 22, 2005 response, the specification indicates that, "The wafer ID recognition sorter 1 recognizes, as the ID of the wafer, a read result having the highest score equal to or higher than an arbitrarily set acceptable score (reference score)." Specification at page 7 lines 16-24 (Emphasis added).

The examiner contends that this is not the same as "highest score" being adopted only if it is equal to a predetermined minimum score. The examiner's position, in applicants' view, begs the question: what exactly is the difference between the "arbitrarily set acceptable score" and a "predetermined minimum score?" Whether arbitrarily set by machine or man, the "arbitrarily set score" becomes a "predetermined minimum score". Thus, the examiner's position, in our view, does not stand up upon reconsideration.

It simply cannot be understood how the examiner cannot request the “arbitrarily set acceptable score” as the predetermined minimum score of the claim. He should explain his rationale clearly in his next response.

In any event, claim 1 is amended in this paper so that the claim limitation “the highest score being adopted only if it is *at least equal to* a predetermined minimum score” is amended to read “the highest score being adopted only if it is *no less than* a predetermined minimum score”. It is submitted that this overcomes the rejection.

Claims 1, 5, 8-9, and 11 are rejected under 35 U.S.C. §102(b) as anticipated by JP 10-227184 (Onu Satoro). Claims 3, 6-7 and 10 are rejected under 35 U.S.C. §103(a) as unpatentable over JP ‘184 in view of Hunter U.S. Patent No. 6,697,517.

The examiner draws the applicant’s attention to paragraphs 0016 and 0017 of Onu Satoro. As read by applicant, it seems that what is disclosed in this paragraph is the selection of the character string of the examiner wafer (Z6W4), as opposed to the adoption of a score “only if it is at least equal to a predetermined score.” Accordingly, Onu Satoro does not anticipate the claimed invention, and in fact teaches away from same.

The applicants observe that in paragraph 0016 of Satoru, it is described that when a light source, such as a light source A, is not well recognized, the light source switches from light source A to the light source B. In contrast, with the present invention, the recognition processing is repeated without depending on the result under a number of conditions registered in advance, and the result is then determined.

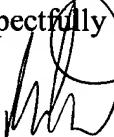
Paragraph 0017 of Satoru indicates that, when all characters cannot be recognized by all light sources, a processing is made based on a coincidence ratio. On the other hand, according to the present invention, since the determination is made by the unit of a character string, if

characters register as NG, then a reading will not be adopted partially. In other words, when there is an NG condition, it is not used for a general coincidence ratio processing. According to the invention, when it does not reach the determination score by the unit of a character string, it will be shifted to make the manual input possible with a generation of an alarm.

Therefore, Ono does not disclose the recitations of independent claim 1. Claims 2, 5, 8, 9, and 11 depend from independent claim 1 and therefore incorporate novel and nonobvious features thereof. Accordingly, claims 2, 5, 8, 9, and 11 are patentably distinguishable over the prior art for at least the reasons that independent claim 1 is patentably distinguishable over the prior art. Therefore, this rejection should now be withdrawn.

Wherefore, based upon the foregoing, it is submitted that the application is in condition of allowance and a relatively early reply to this paper would be appreciated.

Respectfully submitted,



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